

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Hirohisa A. Tanaka, Geoffrey R. Hendrey, and Phillip J. Koopman, Jr.

SERIAL NO.: 09/898,497

FILING DATE: July 5, 2001

TITLE: Method and Apparatus for Location-Sensitive, Subsidized Cell Phone Billing

CONFIRMATION NO: 8442

EXAMINER: Ronald Laneau

GROUP ART UNIT: 3627

ATTY. DKT. NO.: 20662-07121

CERTIFICATE OF EFS-WEB TRANSMISSION			
Pursuant to 240 OG 45 and the <i>Legal Framework For EFS-Web</i> , I hereby certify that this follow-on correspondence is being officially submitted through the USPTO EFS-Web system from the Pacific Time Zone of the United States on the local date shown below.			
Signature:	/Daniel R. Brownstone 46,581/		
Typed or Printed Name:	Daniel R. Brownstone	Dated:	January 25, 2007

MAIL STOP AF
COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

REMARKS ACCOMPANYING REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Claims 1-33 are pending in this application and stand rejected. Applicants are on this date filing a Notice of Appeal and intend to pursue an appeal of claims 1-33.

Pursuant to O.G. Notice 1296 OG 67, Applicants request a Pre-Appeal Brief Conference.

These Remarks are intended to supplement the Request.

The Examiner rejected claims 1, 2, 4, 6-13, 15, 17-24, 26, and 28-33 under 35 U.S.C. § 103(a) as being obvious over Owensby. The Examiner additionally rejected claims 3, 5, 14, 16, 25, and 27 under 35 U.S.C. § 103(a) as being obvious over Owensby in view of Jones.

Applicant previously appealed to the Board of Patent Appeals and Interferences based on an earlier anticipation rejection in view of Owensby, which the Board affirmed on May 4, 2006. The Board held that “Owensby, when dealing with subscribers who are willing to accept ads before and/or during a call will determine whether the location of the cell phone (MU) is inside or outside a predetermined subsidized zone” (Decision, p. 14). The Board additionally found that “If within a zone or calling area where ads (and subsidy) are available, the subscriber will receive the ads and subsidy, the amount of which is determined by the ads available and whether the subscriber will accept ads during a call in addition to before a call . . . If the subscriber’s cell phone is in a location where a subsidy is available, the call is billed at a predetermined billing rate” (*Id.*). Further, “If outside an area where ads (and subsidy) are available, the subscriber will not receive ads (or a subsidy) for the call. . . . If the subscriber’s cell phone is in a location where no subsidy is available, the subscriber is billed at a second predetermined (non-subsidized) billing rate” (*Id.*).

The Board noted that they were “cognizant of the differences between the disclosed inventions of appellants and Owensby,” but that “these differences are not found in appellants’ claim 1. In prosecution before the examiner, there is no reason why appellants cannot amend the claims to distinguish over the teachings of Owensby” (Decision, p. 16).

Following the Board’s decision, Applicants followed the suggestion of the Board and amended the independent claims to recite that the billing rate for a telecommunications connection is adjusted solely responsive to a determination that the mobile telecommunications unit (MU) is inside or outside a predetermined subsidized zone (See Amendment D, July 5, 2006). The amendment highlights a significant difference between the disclosed invention of Applicants and Owensby – Owensby teaches offering a subsidy to a cell phone user if two conditions are met – first, the location of the cell phone must be within a subsidized area, i.e. an area where ads are

offered. Second, the user must agree to accept advertisements. In contrast, claim 1 conditions the use of the first billing rate “responsive solely” to the MU’s location inside the subsidized zone, irrespective of any agreement to receive advertisements or perform any other steps.

In the August 25, 2006 Office Action, the Examiner acknowledged that Owensby does not disclose the use of a first billing rate “responsive solely to a determination that the MU is inside or outside the predetermined subsidized zone” (August 25, 2006 Office Action, p. 3). Instead, the Examiner asserts that it would have been obvious “to utilize the method of Owensby as claimed since dealing [sic] with a mobile unit and it would be appropriate to determine the billing rate based solely to a determination of the MU on the inside or outside the subsidized zone. That would allow the system to target their ads based on the location of the subscriber’s cell phone” (*Id.*).

The Examiner’s rejection is improper. At the outset, Owensby itself discloses targeting ads based on the location of a subscriber’s cell phone (see, e.g., Owensby, paragraph 11), so Owensby need not be combined with anything to achieve this goal indicated by the Examiner. The Examiner has in effect said that adding the missing limitation to Owensby would have been obvious because it would provide a feature already found in Owensby. In any event, selecting an advertisement based on the location of the subscriber’s cell phone does not teach the claimed element of “responsive solely to a determination that the location of the MU is inside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate”. Thus, there is no *prima facie* support for the rejection.

Secondly, the Examiner’s rejection is improper because it would change the principle of operation of Owensby. Owensby teaches directing targeted advertisements to users based on the location of their wireless mobile device, and providing a subsidy to those users who agree to accept the advertisements. That is, if the user agrees to accept advertisements and the user is in an area where advertisements are available, then the user will receive a subsidy. If the user does not agree to view an advertisement, or if the user is in an area where advertisements are not available, then the user does not get a subsidy.

The Examiner states that it would be obvious to combine the teachings of Owensby with the notion of adjusting a billing rate based solely on the MU being within a subsidized zone. Clearly, this would change the principle of operation of Owensby, and would in addition render it unsatisfactory for its intended purpose, because it would mean offering a subsidy to any user located in a zone where advertisements were available, without regard to whether the user was willing to accept an advertisement.

Accordingly, because the rejection both renders Owensby unsatisfactory for its intended purpose and additionally changes its principle of operation, it is improper and should be withdrawn. *MPEP* 2143.01.

Dependent claims 2-11 depend from patentable independent claim 1, and thus derive their patentability from the patentability of claim 1, in addition to reciting their own patentable features. Independent claims 12 and 23 as amended are patentable over Owensby for reasons analogous to claim 1. Dependent claims 13-22 and 24-33 depend from independent claims 12 and 23, respectively, and derive their patentability from the patentability of claims 12 and 23, in addition to reciting their own patentable features.

Respectfully submitted,
Hirohisa A. Tanaka *et al*

Date: January 25, 2007

By: /Daniel R. Brownstone 46,581/
Daniel R. Brownstone, Reg. No. 46,581
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel: (415) 875-2358/Fax: (415) 281-1350
dbrownstone@fenwick.com

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number
20662-07121

Pursuant to 240 OG 45 and the *Legal Framework For EFS-Web*, I hereby certify that this follow-on correspondence is being officially submitted through the USPTO EFS-Web system from the Pacific Time Zone of the United States on the local date shown below.

on January 25, 2007Signature (Daniel R. Brownstone 46,581)Typed or printed
nameDaniel R. BrownstoneApplication Number
09/898,497Filed
July 5, 2001First Named Inventor
Hirohisa A. TanakaArt Unit
3627Examiner
Ronald Laneau

This request is being filed with a notice of appeal.

I am the

☐ applicant/inventor./Daniel R. Brownstone 46,581/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Daniel R. Brownstone

Typed or printed name

☐ attorney or agent of record.

Registration number _____

(415) 875-2358

Telephone number

☒ attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 46,581January 25, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 of 1 forms is submitted.